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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,598	11/27/2001	Kristen L. Bhatti	10017080-1	8694

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EXAMINER

NGUYEN, HOAI AN D

ART UNIT PAPER NUMBER

2854

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicant No.	Applicant(s)
	09/993,598	BHATTI, KRISTEN L.
	Examiner	Art Unit
	Hoai-An D. Nguyen	2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 18 March 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 27 November 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (6,089,765) in view of Housel et al. (2002/0048041).

#### **Mori teaches a print system and printer comprising:**

- A job retention system (FIG. 3, printer controller 31) configured to store print-ready information corresponding to a print task (Column 3, lines 2-5 and 19-20) and to receive an input corresponding to a selected portion of the print-ready information, the print-ready information being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device (Column 3, lines 10-43), with regard to claims 1, 4-7 and 10.

#### **However, Mori does not specifically teach the followings:**

- The job retention system being further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.

#### **Meanwhile, Housel et al. teaches a printing system comprising:**

- The printing system 26 (FIG.1) being further configured to enable the selected portion of the print task to be printed without printing a non-selected portion of the print task (Paragraphs 0035-0037 and 59-61), with regard to claims 1, 4-7 and 10.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Mori to permit the user to print only a **selected portion of a print task** taught by Housel et al., since Housel et al. teaches that this structure enables the users to easily designate their desired print jobs when inputting their request commands at the printer.

**Mori teaches all that is claimed, a print system and printer further comprising:**

- A printing device (FIG. 3, printer 10) having a memory (FIG. 3, RAM 13), the print-ready information being stored in the memory of the printing device (Column 3, lines 19-21), with regard to claims 2, 3 and 11.
- Printing the selected portion of the information in the print-ready format using the printing device (Column 3, lines 26-27), with regard to claims 2.
- The job retention system (FIG. 3, printer controller 31) resides in the printing device, with regard to claim 11.
- The printing device includes a user interface, wherein the user interface is a graphical user interface (FIG.3, LCD 18), with regard to claims 7, 8, 12 and 13.
- A workstation (FIG.1, computer 20) communicatively coupled to the printing device (FIG.1, printer 10), the workstation having a driver, the driver being configured to convert information into the print-ready information and provide

the print-ready information to the painting device, the driver being further configured to provide a graphical user interface (Column 3, lines 1-9 and 56-59), with regard to claims 14 and 15.

- Means (FIG. 1, RAM 13) for storing the information in the print-ready format (Column 3, lines 30-36), with regard to claim 16.
- The means for storing the information in the print-ready format is a disk drive (Column 3, lines 37-39), with regard to claim 17.
- The disk drive is a component of the printing device (Column 3, lines 30-39), with regard to claim 18.
- The means (FIG. 1, printer driver 42) for configuring the information is associated with a driver, the driver being configured to receive information in a non-print-ready format and convert the information to the print-ready format (Column 3, lines 1-9), with regard to claims 9, 19 and 20.
- The selected portion of the print-ready information defines a page of the print task (Column 3, lines 30-32), with regard to claim 21.
- The selected portion of the print-ready information defines a range of pages of the print task (Column 3, lines 39-43), with regard to claim 22.
- Storing a collection of information in the print-ready format corresponding to a plurality of print tasks in the memory (Column 5, lines 17-64), with regard to claim 23.

**However, Mori does not specifically teach the following either:**

- A user interface being configured to enable a user to select at least a portion of the print task.

**Meanwhile, Housel et al. teaches a printing system comprising:**

- A user interfaces (FIG.1, user interfaces 13) being configured to enable a user to select at least the portion of the print task (Paragraphs 0092 –0097), with regard to claims 9, 12 and 15.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Mori to incorporate the teaching of the usage of a graphical user interface since Housel et al. teaches that such an interface is beneficial for permitting a user to check the status of a the print job or jobs or to determine how the print jobs are set up.

***Response to Arguments***

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mori teaches a printer driver that converts the print data into information in print-ready-format (Mori, column 3, lines 1-5), and Housel et al teaches a printing device that enables to select a portion of a print job (Housel et al., paragraphs 59-61). Therefore, it would

have been obvious to one having ordinary skill in the art to modify Mori to permit portions of the print ready information to be selected and printed since Housel et al. teaches that enabling a selected portion of a print job to be printed is beneficial for permitting a user to more easily designate their print jobs.

*Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**CONTACT INFORMATION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoai-An D. Nguyen whose telephone number is (703) 305-3343. The examiner can normally be reached on M-F (8:00 - 5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Hoai-An D. Nguyen  
Examiner  
Art Unit 2854

HADN  
May 21, 2003



ANDREW H. HIRSHFELD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800